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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,422	02/22/2002	David M. Prestipino	47168-00216	1031
30223	7590	04/21/2005		
JENKENS & GILCHRIST, P.C. 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606			EXAMINER LEWIS, RALPH A	
			ART UNIT 3732	PAPER NUMBER

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/081,422	Applicant(s) PRESTIPINO, DAVID M.	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-23 is/are allowed.
- 6) ☒ Claim(s) 1-20 and 24-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Rejections based on Prior Art

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 and 24-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beaty et al (US 5,419,702) in view of Lazzara et al (US 5,863,201).

In Figure 7 Beaty et al disclose an implant analog 54' for use in developing a dental prosthesis for a dental implant 10 (Fig. 1). The Beaty et al analog has an unthreaded main body with a flat section and a lower grooved section that is to be fixedly engaged in the stone 52' of model 50'. The lower main body portion of Beaty et al appears to be nearly identical in shape to that illustrated by applicant. The Beaty et al model includes soft modeling material 80 that surrounds the upper portion of the implant analog 54' and is intended to replicate gingival tissue. The Beaty et al implant analog 54' has an upper portion that extends above the bone that is intended to replicate the upper section of implant 10 that extends above the bone. The Beaty et al implant has no upper groove that extends above the bone, consequently the Beaty et al Figure 7 analog lacks the claimed "upper groove."

Lazzara et al, however, disclose an implant 10 that includes an upper groove 14 that is intended to extend above the bone. Lazzara et al indicate that the implant is intended to be used such that the upper groove 14 engages gingival tissue and the

lower threaded region engages bone. Lazzara et al do not disclose an implant analog for their implant. The ordinarily skilled artisan, however, would have found it obvious in practicing the Lazzara et al invention to turn to the prior art for guidance in creating a prosthesis for the implant. Beaty et al teach the conventional manufacture of a prosthesis with an implant analog 54' for the implant 10 of Figure 1. The Lazzara et al implant 10 differs from the Beaty implant 10 in that the Lazzara et al implant has a groove 14 that extends above the bone whereas the Beaty et al implant has no groove. Consequently, when the ordinarily skilled artisan went to make an implant analog for the Lazzara et al implant based on the prior art teachings of Beaty et al, the ordinarily skilled artisan would have found it obvious to have provided an upper groove in the prior art Beaty et al implant analog which extends above the bone in order to match the groove in the implant of Lazzara et al.

In response to the present rejection applicant argues that there is no motivation to combine Lazzara et al and Beaty et al. The examiner disagrees. The rejection is based on the Beaty et al implant analog 54' being modified to replicate the above bone structure of the Lazzara et al implant so that a prosthesis may be fabricated for the Lazzara et al implant in a conventional manner. There is certainly motivation for such a modification.

Applicant also argues that the groove on their analog is not intended to replicate any structure on the dental implant. While this may be true, it is unclear how it relates to the combination used in the rejection. Applicant further argues that for fabricating the prosthesis of the Lazzara et al implant one would only need for an implant analog the

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upper polygonal surface to which the prosthesis is attached and that replicating exterior implant structure in an analog that is below the upper surface would be wasteful and unnecessary. The examiner disagrees, the purpose of the model and analog on which the prosthesis is constructed is to give dental technicians a visual and physical understanding of how the prosthesis mounted on the implant will look in the patient's mouth. The more accurate the model is the more accurate will be final prosthesis.

Applicant also argues that in Lazzarra et al that the groove 14 may not typically be present above the bone until after up to 18 months as Lazzarra et al indicates that the bone typically recedes to that level. Applicant asks "why would one . . . conclude that the implant analog should have an upper groove to match the neck portion 14 of Lazzarra's implant when there is no possibility that the neck portion would ever receive or contact the impression material that is used with the implant analog to create a model?" The examiner is of the position that one would desire a model of the Lazzarra et al implant/jaw structure that mimics the "steady state" structure found after 18 months so that a more accurate prosthesis may be constructed. The more accurate the model is to the jaw structure and implant, then the better the design of the prosthesis.

Allowable Subject Matter

Claims 21-23 are allowed.

Action Made Final


THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
September 17, 2004


Ralph A. Lewis
Primary Examiner
Au3732